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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/024,557	12/21/2001	Takuya Ogane	2185-0607P	3620

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EXAMINER	
LEE, RIP A	

ART UNIT	PAPER NUMBER
1713	

DATE MAILED: 02/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No.	Applicant(s)
	10/024,557	OGANE, TAKUYA
	Examiner	Art Unit
	Rip A. Lee	1713

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 January 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☒ The proposed amendment(s) will not be entered because:

   (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ they raise the issue of new matter (see Note below);

   (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☐ The a)☐ affidavit, b)☐ exhibit, or c)☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a)☒ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: 1-12.

   Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. ☒ Other: attachment to advisory action

Attachment to Advisory Action

This advisory action follows an after-final response filed on January 7, 2004. Proposed amendments to claims 1-12 were submitted.

Applicants traverse the rejection of claims set forth previously (Ushioda *et al.* and Smith) under 35 U.S.C. 103(a) and assert that the subject matter of the present claims is not taught by the prior art.

The present invention is drawn to a process for making a solid catalyst component not all too dissimilar from that practiced routinely in the art. In its simplest form, this comprises combining a transition metal component, a support particle and aluminoxane. Applicants claim that the discerning step in their process is the separation of "fine-powdery components" and "shapeless components" using differences in sedimentation velocity. This seemingly dynamic process in which the speed of materials is being actively measured for purposes of separation amounts merely to particles that precipitate and those that do not. It can be seen from the specification that upon mixing ingredients, some particles are dense enough to land at the bottom of the vessel, and those that are fine and powdery, or shapeless, do not. They remain flocculent, and are summarily discarded along with the supernatant liquid.

The rejection acknowledges that neither Ushioda *et al.* nor Smith fails to recite that the supernatant does not contain "fine-powdery component" and "shapeless component." Indeed, were the subject matter recited in the prior art, the basis of the rejection would be shifted to one of anticipation rather than one of obviousness.

However, the rejection of record is based on obviousness. And, in light of the fact that the steps outlined in the prior art were essentially the same as that described in the present claims, there was little reason to believe that the supernatant is devoid of such material. That is, since processes were essentially the same, a reasonable basis existed to believe that "fine-powdery component" and "shapeless component" were formed in the catalyst preparation step. Therefore, in accord with *In re Best*, the burden of proof was shifted to the Applicants to establish an unobviousness difference.

In response, Applicants have taken the expedient of applying a dictionary definition of "supernatant" to passages culled from Ushioda *et al.* and Smith in order to arrive the conclusion that, according to the prior art, absolutely no "fine-powdery component" and "shapeless component" exists in the upper layer because it has precipitated completely.

It must be kept in mind that the dictionary merely teaches how a word is used. It does not define the actual status of the art, as Applicants have attempted to show. If definitions were to be taken as absolute, then Applicants' "shapeless" component has no form. In other words, it is a liquid or gas, or it does not exist. Clearly, this is not what Applicants are claiming. The use of "supernatant," in context of the art, is used to describe the liquid layer from which a material precipitated. *Ideally*, said layer is purely liquid, but in practice, fine particulate matter remains suspended in the liquid, and in some cases, such a mixture would appear to be "clear." Such a notion is obvious any chemist having ordinary skill in the art. As such, removal of the supernatant includes "removal of fine powdery component," as recited in the claims.

Applicants were to show that this was not the case in the scenario presented by Ushioda *et al.* and Smith. That is, the burden of proof was shifted to Applicants to show that the process of the prior art is devoid of "fine-powdery component" and "shapeless component." Logomachy notwithstanding, it is maintained that Applicants have not sufficiently met their burden of proof establishing unobviousness over the prior art. Consequently, the rejection of record has not been withdrawn.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rip A. Lee whose telephone number is (571)272-1104. The examiner can be reached on Monday through Friday from 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached at (571)272-1114. The fax phone number for the organization where this application or proceeding is assigned is (571)273-1104.

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January 29, 2004

DAVID W. WU
SUPERVISORY PATENT EXAMINER
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